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EXAMINER

MORROW, JASON S

ART UNIT PAPER NUMBER

3612

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/601,193

Applicant(s)

COCAIGN, JEAN-GUY

Examiner

Jason S. Morrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: In line 8, the word "permanent" should be changed to --permanently-- for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Schlecht et al.

Re claim 1, Schlecht et al. discloses a roof module for closing an opening in a roof of a motor vehicle that extends transversely between two lateral roof elements and in a lengthwise direction between a front roof element and a rear roof element, and the lateral roof elements, the front roof element and the rear roof element each having a peripheral rabbet on edges thereof which border the opening, the roof module comprising a glass pane (9) adapted for permanent connection directly to the peripheral rabbets which border the opening, a darkening device (13) which is deployable parallel to an inside surface of the glass pane, guide means (19, 21) for guiding the darkening device, the guide means being permanently mounted directly on the inside

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surface of the glass pane along each of opposite side edges of the glass pane (see figure 3), the guide means interacting with edges of the darkening device, a support brace (66) mounted on the inside surface along one of front and rear transverse edges of the glass pane, the support brace having a motor drive (47) for driving the darkening device.

Re claim 2, the glass pane is adapted to be mounted on the peripheral rabbets by cementing (62).

Re claim 3, each guide means is directly mounted by cementing on the inside surface of the glass pane (see figure 3).

Re claim 4, the support brace is directly mounted on the inside surface of the glass pane by cementing (see figure 4).

Re claim 6, the darkening device comprises a roll-up blind (35) which is permanently connected to the brace.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlecht et al. in view of Clenet.

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Schlecht et al. discloses all the limitations of the claim, as applied above, except for the darkening device comprising louvers.

Clenet teaches a darkening device comprising louvers (see figure 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a darkening device, such as that disclosed by Schlecht, to be comprised of louvers, as taught by Clenet, in order to construct the darkening device in alternative manner for aesthetic considerations.

6. Claims 7-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlecht et al. in view of German Publication 19955710 (hereafter Paetz).

Re claim 7, Schlecht et al. discloses a front element (7), a rear element (8), side elements (4, 5) extending in a lengthwise direction between the front element and the rear roof element at opposite lateral sides, a peripheral rabbet (as shown in figure 3) on inner edges of the side elements, the front element and the rear element which border an opening defined thereby, and a module having a glass pane (9) permanently mounted directly on the peripheral rabbets, a darkening device (13) carried by the glass pane and deployable parallel to an inside surface of the glass pane, guide means (19, 21) for guiding the darkening device, the guide means being permanently mounted directly on the inside surface of the glass pane along each of opposite side edges of the glass pane, the guide means interacting with the edges of the darkening device, a support brace (66) mounted on the inside surface along one of front and rear transverse edges of the glass pane, the support brace having a motor drive (47) for the darkening device.

Re claim 8, the glass pane is mounted on the peripheral rabbets with cement (62).

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Re claim 9, each guide means is directly mounted on the inside surface of the glass pane with cement (as shown if figure 3).

Re claim 10, the support brace is directly mounted on the inside surface of the glass pane with cement (as shown in figure 5).

Re claim 12, the darkening device comprises a roll-up blind (35) which is permanently connected to the brace.

Schlect et al. does not teach the front element, the rear element, the side elements and the module all being part of a roof.

Paetz teaches a front element, a rear element, side elements and a module all being part of a roof (see figure 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a device, such as that disclosed by Shlecht et al., to be used in a vehicle roof such that the front element, the rear element, the side elements and the module are all part of a roof, as taught by Paetz, in order to simplify the construction of a vehicle roof with a transparent panel.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlecht et al. and German Publication 19955710 (hereafter Paetz) as applied to claims 7-10 and 12 above, and further in view of Clenet.

Schlecht et al. and Paetz disclose all the limitations of the claim, as applied above, except for the darkening device comprising louvers.

Clenet teaches a darkening device comprising louvers (see figure 3).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a darkening device, such as that disclosed by Schlecht et al and Paetz above, to be comprised of louvers, as taught by Clenet, in order to construct the darkening device in alternative manner for aesthetic considerations.

Response to Arguments

8. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason S. Morrow whose telephone number is (703) 305-7803.

The examiner can normally be reached on Monday-Friday, 8:00a.m.-4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 14, 2004

Jason S. Morrow
Examiner
Art Unit 3612


JASON MORROW
PRIMARY PATENT EXAMINER

10/14/04